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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,969	09/04/2003	Jay S. Walker	02-058	8907
22927 7590 04/01/2009 WALKER DIGITAL MANAGEMENT, LLC 2 HIGH RIDGE PARK STAMFORD, CT 06905				
EXAMINER				
SAGER, MARK ALAN				
ART UNIT		PAPER NUMBER		
3714				
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04/01/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/655,969

Applicant(s)

WALKER ET AL.

Examiner

M. Sager

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42, 43, 47, 48 and 51-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42, 43, 47, 48 and 51-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/12/09 has been entered and it cancels claims 44-46 and 49-50; thus examination proceeds on pending claims 42-43, 47-48 and 51-61; while claims 10-41 remain withdrawn.

Election/Restrictions

2. This application contains claims 10-41 drawn to an invention nonelected without traverse (implicit) in the reply filed on May 30, 2007. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.02.

Claim Interpretation

3. Per MPEP 2111.04, claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are (A) "adapted to" or "adapted for" clauses, (B) "wherein" clauses, and (C) "whereby" clauses. The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it

cannot be ignored in order to change the substance of the invention." Id. However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." Id. In this case, the 'wherein' clause of claims 51-61 merely states its environment of use, intended result or the clause fails to state a condition material to its patentability as in evidence below.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 47-48 and 51-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 47-48 and 51-61 each recites the limitation "the method" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. Claims 42-43, 47, 51 and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Wynn (5971271). Wynn discloses a computer readable medium encoded with instructions to perform a concierge service system (abstract, 2:10-3:29, 5:7-11:64, figs 1-20A) teaching to determine a player engaged in gaming activities at a gaming device would like to communicate with another (abstract, 2:10-3:29, 5:7-11:64, figs 1-20A) having access to a portable communication device (abstract, 2:10-3:29, 5:7-28, figs 1-20A, ref 16), monitor gaming activities of a player at a gaming device (abstract, 2:10-3:29, 5:7-6:45, 7:28-9:33, 11:1-64, figs 1-20A), obtain a player identifier (abstract, 2:10-3:29, 4:45-59, 5:7-6:45, 7:28-9:33, 11:1-64, figs

1-20A), determine an individual who will communicate with player (abstract, 2:10-3:29, 5:7-6:45, 7:28-9:33, 11:1-64, figs 1-20A, concierge) and enable communication between player and individual via the portable communication device (abstract, 2:10-3:29, 5:7-6:45, 7:28-9:33, 11:1-64, figs 1-20A), determine, based on the gaming activities, a prompt comprising an offer for product or service to be presented by an individual to the player and transmit the prompt to the individual (abstract, 2:10-3:29, 5:7-6:45, 7:28-9:33, 11:1-64, figs 1-20A), enabling the individual to provide a service to the player (abstract, 2:10-3:29, 5:7-6:45, 7:28-9:33, 11:1-64, figs 1-20A).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 42-43, 47-48 and 51-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (6139431) in view of Wynn (5971271). Walker discloses a gaming device and method teaching claimed steps/features including an apparatus having a processor and a memory that stores a program and a computer readable medium (figs 1-9), determine a player engaged in gaming activities at a gaming device would like to communicate with another (3:28-42, 10:44-47) having access to a portable communication device (53-57, ref 6), monitor gaming activities of a player at a gaming device (fig 1-9, esp. 8a-9, ref 300, 'player tracking'), obtain a player identifier (5:57-64, 6:49-65), determine an individual who will communicate with player (3:28-42 or use of cellular telephony circuitry to connect to another) and enable communication between player and individual via the portable communication device (2:29-67, 3:28-42, 49-11, fig 8a-9), however, Walker lacks determine, based on the gaming activities, a prompt comprising an offer for product or service to be presented by an individual to the player and transmit the prompt to the individual. The Office notes the equivalence of offer for product and offer of a service in that each is an offer and that the form of product or service is non-critical. Next, in a related reference, Wynn discloses a computer readable medium encoded with instructions to perform a concierge service system (abstract, 2:10-3:29, 5:7-11:64, figs 1-20A) teaching determine, based on the gaming activities, a prompt comprising an offer for product or service to be presented by an individual to the player and transmit the prompt to the individual such that player information obtained from player tracking system is displayed to prompt concierge and to

offer service to aid player with their request such as transfer of funds or operation of a particular game/machine (abstract, 2:10-3:29, 5:7-6:45, 7:28-9:33, 11:1-64, figs 1-20A). Wynn is analogous art for either being in the field of applicant's endeavor or, being reasonably pertinent to the particular problem with which the applicant was concerned. See *In re Octiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill in the art is as demonstrated by the references. In consideration of US Supreme Court decision in *KSR*, that 'known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art', it would have been obvious to an artisan at a time prior to the invention to apply the process of determine, based on the gaming activities, a prompt comprising an offer for product or service to be presented by an individual to the player and transmit the prompt to the individual as taught by Wynn to improve the process of Walker for the predictable result of alerting concierge to player information so as to be better informed regarding the player and their preferences so as to provide better faster service with a personal touch thereby to ensure a more satisfied customer (2:10-45, 2:63-3:24, 5:10-28, 6:12-42, 7:28-8:55, 9:15-33, 11:1-64).

Regarding claim 48, as best understood, Walker includes altering the state of the gaming device based on an input received from the individual for casino operator change of parameters (11:49-67) or based on request by player at the gaming machine who request assistance via portable communication device as to how to effect a change such that the individual assists in increasing credit balance thereby altering device via increased funds so player may then continue to play (3:27-44, 10:46-47) or receive assistance on how to effect a change of game parameters (3:11:49-67, 3:66-4:11, 8:15-32) to provide player assistance in altering game device parameters

such as locking/unlocking game device. Regarding claim 56 and 59, Walker [in view of Wynn] lacks specifically identifying storing email address and debit; however, Walker states player identification information denotes any information or compilation of information that uniquely identifies a player (4:51-63, 5:52-65, ref. 4440-4448). The Office notes the equivalence of the various forms of identifiers to identify a player and notes the lack of criticality based on teachings within Walker. Since email address and debit is each another equivalently known user identifier, it would have been obvious to an artisan at a time prior to the invention to apply the process of email address and debit as known to Walker to identify player. Essentially, although email address and debit card number is each another identifier, it fails to patentably distinguish over identifiers taught by Walker.

11. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wynn in view of Walker (WO96/00950), and claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Wynn as applied to claim 43 above, and further in view of Walker (WO96/00950). Alternatively, as best understood, Wynn and Walker in view of Wynn each disclose claimed method (supra) but lack altering the state of the gaming device based on an input received from the individual includes casino operator change of parameters. In related references, Walker '950 discloses a system where a player using a dedicated gaming computer [a portable communication device] provided by wagering establishment (29:18-22, ref 14) may request a wagering authority 16 to resolve a dispute and alter the state of the gaming device based on input received from the individual at the wagering establishment and acceptance by the player (31:15-23). Walker '950 is analogous art for either being in the field of applicant's endeavor or, being reasonably pertinent to the particular problem with which the applicant was

concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill in the art is as demonstrated by the references. In consideration of US Supreme Court decision in *KSR*, that 'known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art', it would have been obvious to an artisan at a time prior to the invention to apply the process of altering the state of the gaming device based on an input received from the individual includes casino operator change of parameters as taught by Walker '950 to improve the process of Wynn or the process of Walker '431 in view of Wynn for the predictable result of resolving a dispute to player acceptance.

12. Claims 52-53, 55-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wynn in view of Walker '983. Wynn discloses steps of claimed invention (*supra*) including tracking card and player name (abstract, 2:10-3:29, 4:45-59, 5:7-6:45, 7:28-9:33, esp. 4:45-59, 8:42-50) but lacks other identifiers claimed. In related reference, Walker '983 discloses a computer readable medium encoded with instructions for directing a processor to perform steps of method including obtaining a player identifier of player name, address, phone number, hotel room number, payment identifier, credit card number, financial account number, home billing address (ref. 4440-4448). Regarding email and debit card, Walker '983 states player identification information denotes any information or compilation of information that uniquely identifies a player (4:51-63, 5:52-65). The Office notes the equivalence of the various forms of identifiers to identify a player and notes the lack of criticality based on teachings within Wynn and Walker. Walker '983 is analogous art for either being in the field of applicant's endeavor or, being reasonably pertinent to the particular problem with which the applicant was concerned. See

In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill in the art is as demonstrated by the references. In consideration of US Supreme Court decision in KSR, that 'known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art', because Wynn and Walker each pertain to methods for identifying a player, it would have been obvious to an artisan at a time prior to the invention to substitute one method for the other to achieve the predictable result of identifying player. Regarding email and debit card, Walker '983 states player identification information denotes any information or compilation of information that uniquely identifies a player (4:51-63, 5:52-65). The Office notes the equivalence of the various forms of identifiers to identify a player and notes the lack of criticality of email and debit card number based on teachings within Wynn and Walker.

Response to Arguments

13. Applicant's arguments with respect to claims 42-43, 47-48 and 51-61 have been considered but are moot in view of the new ground(s) of rejection.

14. Applicant's arguments, see section 2.1, pages 11-12, filed Mar 12, 2009, with respect to the rejection(s) of claim(s) under 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Wynn.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/
Primary Examiner, Art Unit 3714